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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/822,402

04/12/2004

Jason L. Tebeau

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CHRISTIE, PARKER & HALE, LLP  
PO BOX 7068  
PASADENA, CA 91109-7068

EXAMINER

LEVINE, ADAM L

ART UNIT

PAPER NUMBER

3625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/03/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/822,402

Applicant(s)

TEBEAU ET AL.

Examiner

Adam Levine

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input checked="" type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)                    | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application for the reasons indicated in the attached "Notice of Draftsperson's Patent Drawing Review," PTO-948. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required

Claims 1-4 provide for the use of a communications link, or possibly several communications links, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. The claims recite uses for the communications links without reciting the steps involved in the uses. They read like means plus function type claims such as would be appropriate in system or apparatus claims rather than method steps.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is inoperative and therefore lacks patentable utility.** The claims do not set forth any steps involved in the method/process. Because there are no active steps the claims do not set forth any useful, concrete, and tangible result.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

### ***Specification***

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 1. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**3. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jorba (US Pub.No.2002/0243802) in view of Nashed (US Pat.No. 6,654,749).**

Jorba teaches a computer implemented method of on-line merchant authorization. Jorba teaches using communication links between consumer host, merchant host, and authorization database to provide insignia indicating merchant authorization to sell a product. Jorba also teaches using additional systems and methods to protect against copying of the insignia. Jorba further teaches:

- providing an authorization database: of on-line merchants authorized to sell a particular brand of product offered for sale by a particular manufacturer (see at least page 1 para.0012, page 3 para.0032, page 4 para.0075)
- providing a communications link: for the manufacturer to enter authorization data in the authorization database, said authorization data including information relating to on-line merchants who have been (are) authorized by the manufacturer to sell the manufacturer's particular brand of product on-line (see at least abstract, figs.2,4; pages 2-3 para.0032-0033, page 4 para.0075. Please note: The "company that is licensing authorized retailers" is the manufacturer in this case.); from an on-line merchant host to both a customer host and the authorization database, the on-line merchant host hosting an on-line merchant's website (see at least page 1 paras.0006-0007, pages 1-2 paras.0011-0012, pages 2-3 para.0032);

- providing authorization information to the merchant's website: via the communications link from the authorization database to the on-line merchant host to verify for a customer accessing the on-line merchant's website whether or not the on-line merchant host is authorized by the manufacturer to sell the particular brand of product on-line (see at least page 1 paras.0006-0008, pages 1-2 paras.0011-0012, pages 2-3 para.0032); providing an insignia to be visible to the customer on the on-line merchant's website (see at least page 1 paras.0006-0008; and granting use of the insignia on the merchant's website via authentication controlled by a communications link from an authorization server controlled by the product's manufacturer, in which use of the insignia is granted to verify authorization to sell the manufacturer's particular product on-line (page 1 paras.0001-0003,0008; pages 2-3 paras.0032-0037); controlling the granting of use of the insignia via a system that protects against copying (see at least abstract, page 1 paras.0003,0006-0008, pages 2-3 paras.0032-0037).

Jorba teaches all the above as noted and teaches a) a customer locating an on-line merchant website, b) the customer being referred to an on-line merchant's website in search of a product, c) the customer, merchant, and authorization database using various communication links to access each others' services, and d) the customer purchasing product from the on-line merchant using the method. Jorba however does not disclose:

- providing a communications link from an on-line search engine: to both a customer host and the authorization database;

- providing a communications link in the search engine: to select an option to search the authorization database having only authorized on-line merchants, so that a customer communicating with the search engine via the customer host can select the option to verify whether or not the on-line merchant host is authorized by the manufacturer to sell the particular brand of product on-line.

Nashed teaches on-line merchant authorization using communication links between consumer host, merchant host, and authorization database indicating merchant authorization to sell a product. Nashed also teaches a) a customer locating an on-line merchant website, b) the customer being referred to an on-line merchant's website in search of a product, c) the customer, merchant, and authorization database using various communication links to access each others' services, and d) the customer purchasing product from the on-line merchant using the method. Nashed also discloses:

- providing a communications link from an on-line search engine: to both a customer host and the authorization database (see at least abstract, figs. 1-2, column 2 line 27-column 3 line 35, line 45-column 4 line 5, column 4 line 58-column 5 line 11, column 6 lines 1-24, column 6 line 54-column 7 line 29);
- providing a communications link in the search engine: to select an option to search the authorization database having only authorized on-line merchants, so that a customer communicating with the search engine via the customer host can select the option to verify whether or not the on-line merchant host is authorized by the manufacturer to sell the particular brand of product on-line (see at least



see at least abstract, figs.1-2, column 2 line 27-column 3 line 35, line 45-column 4 line 5, column 4 line 58-column 5 line 11, column 6 lines 1-24, column 6 line 54-column 7 line 29, column 7 line 44-column 9 line 10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Jorba include providing a communications link from an on-line search engine to both a customer host and the authorization database, and a communications link in the search engine to select an option to search the authorization database having only authorized on-line merchants, as taught by Nashed, in order to facilitate internet commerce and thereby attract more customers and merchants to the service.

*Pertaining to system claim 5*

Rejection of claim 5 is based on the same rationale as noted above.

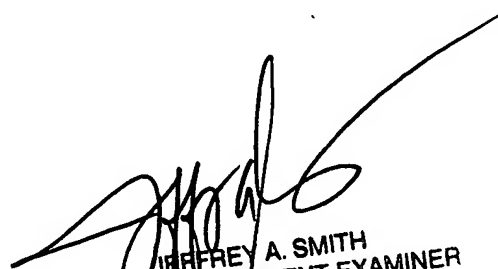
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine  
Patent Examiner  
December 14, 2006



JEFFREY A. SMITH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600